

In response to the deficiency in Garcera, the Examiner cites Childs, which relates to a pore filling gel, and which is taught in Figure 5 thereof to be situated near either side of the membrane. With this, the Examiner concludes that it would be obvious to move the pore-filled layer of Garcera from its location on the outside of the membrane to the inner side of the membrane adjacent the separation layer. The Examiner offers a number of reasons to justify the modification of Garcera and these reasons can be summarized as follows.

- 1) Advantages would be obtained by moving the pore-filled layer of Garcera to the inside of the membrane;
 - a) the Examiner concludes that moving the pore filling to face the separation layer would obtain the benefit of a reduced pressure drop;
 - b) the Examiner asserts that the potential of a fluid stagnation zone would be eliminated by moving the pore-filled layer of Garcera; and
 - c) the Examiner contends that by moving the pore filling to adjacent the separation layer, the benefit of reduced fouling would be achieved.
- 2) The pore filling of Garcera, although not explicitly recognized as having a separating effect, would inherently have such a feature and could be used in tandem with the separating layer of Garcera.
- 3) Childs and Garcera are both concerned with pore-filled layers and because of this, it is proper to take the teaching of Childs and use them to modify the configuration of Garcera.

Applicant submits that the Examiner has committed errors in the reasoning used to support the rejection and these errors mandate a withdrawal of the rejection.

To demonstrate the errors in the Examiner's reasoning, Applicant submits a second Declaration under Rule 1.132 from the expert André Grangeon (the Second Declaration). This Second Declaration addresses each of the points made above under 1.(a.-c.), 2, and 3 and demonstrates that the Examiner has made errors by either speculating on advantages used to formulate the rejection, making errors concerning the interpretation of the teaching of Garcera on inherency, and ignoring the fundamental differences between the two references that preclude making the modification of Garcera proposed in the rejection.

Referring to the Second Declaration, in Section I, the Declarant points out that each of the advantages noted in the rejection and listed in 1.(a.-c.), i.e., reduced pressure drop, elimination of the fluid stagnation zone, and reduced fouling would not occur by changing the position of the pore-filled layer of Garcera. What this means is that the Examiner is using reasoning to formulate the rejection without the required factual underpinnings and because of this, these reasons cannot support the allegation of obviousness.

In Section II, the Second Declaration demonstrates in detail that it is error for the Examiner to treat the pore filled layer of Garcera as an inherently separating layer. The correct interpretation of the teachings of Garcera as shown in the Second Declaration is that there is no molecule or particle stop caused by the pore filled layer of Garcera. This means that the Examiner's reasoning to put the pore-filled layer next to

the separation layer for the benefit of added separation is not factually supported and cannot be used as a reason for justifying the modification of Garcera.

In Section III, the Second Declaration explains in detail that when considering the specific teachings of Childs and Garcera, it is error for the Examiner to equate the two for the purposes of moving the pore-filled layer in Garcera from its existing location to one adjacent the separation layer.

To justify the use of the teachings of Childs to formulate the rejection, the Examiner takes a broad brush approach to the teachings of Childs and Garcera by generally characterizing them as pore filled membrane supports. Applicant does not dispute this broad characterization. However, the Examiner cannot ignore the other teachings of Garcera and Childs when coming to a conclusion of obviousness. The Examiner cannot pick and choose from select teachings of the prior art to formulate a rejection and ignore other teachings of the prior art that are more relevant when considering the question of obviousness. See *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2D (BNA) 1596 (Fed. Cir. 1988) ("cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."). The artisan would not put on blinders when assessing the teachings of Garcera and Childs and ignore the differences that are outlined in the Second Declaration.

In fact, Childs does not provide the motivation to move the pore-filled layer from its existing position in Garcera to one adjacent the separation layer as proposed by the

Examiner. Since the proposed modification of Garcera cannot be legitimately derived from Childs, a *prima facie* case of obviousness against claim 1 does not exist.

Applicant also wants to make reference to the entirety of the earlier and first Declaration of Grangeon to support the arguments of patentability against the combination of Garcera and Childs.

Referring to the last page of Grangeon's first Declaration, in the event that the Examiner would say that Childs can be the primary reference and be modified by including a separation layer as taught in Garcera, this rejection would also be improper. That is, Childs gel-filled layer is the separation layer, with the difference being that the separation layer, i.e., the pore filled layer, in Childs is part of the support. One of skill in the art would not find it obvious to add another separation layer when one already exists in Childs. The flaw in this hypothetical approach is analogous to the flaw in the approach for the rejection based on Garcera. Just as one of skill in the art would not modify Childs with another separation layer that covers the surface of the membrane, one of skill in the art would have no reason to use the gel-filled impregnation separation layer and its placement in Childs as a motivator to change the position of the pore filling layer of Garcera, which is fundamentally different from the gel-filled impregnation layer of Childs.

The Examiner's reliance on Grangeon to reject claim 9 is noted. However, Grangeon does not remedy the flaws in the rejection as outlined above. Consequently, even if Grangeon were used for the purpose stated in the rejection of claim 9, this does not mean that the defects in the rejection of claim 1 are cured.

To summarize, Applicant submits that the Examiner has committed a number of errors in formulating the reasoning to support the modification of Garcera. These errors taint the rejection of claim 1 and its dependent claims and a valid *prima facie* case of obviousness cannot be said to exist based on Garcera and Childs.

Accordingly, the Examiner is requested to consider the Second Declaration and arguments made above and pass all pending claims onto issuance.

The undersigned as well as Applicant's overseas representative would also like to conduct a telephone interview with the Examiner and his supervisor to advance prosecution of this application and discuss the sufficiency of the Second Declaration. As such, Applicants will contact the Examiner to determine a time frame when this RCE will be ready for examination so that the interview can be scheduled to correspond to the Examiner's requirement to act on this application.

The above constitutes a complete response to all issues raised in the outstanding Office Action.

Again, reconsideration and allowance of this application is respectfully requested.

Applicant petitions for a three month extension of time. Please charge Deposit Account No. 50-1088 the fee of \$555.00.

Please charge any fee deficiency or credit any overpayment to Deposit Account
No. 50-1088.

Respectfully submitted,
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